Remarks

Overview

In the Office Action under reply, all of the pending claims, i.e., claims 1-64, were examined and rejected. The grounds for rejection are as follows:

Claims 1-7 and 11-64 stand rejected under 35 U.S.C. §35 U.S.C. §102(b) as being anticipated by Hawker et al. (US Patent No. 6,107,357, hereinafter "Hawker"); and

Claims 8-10 stand rejected under 35 U.S.C. §35 U.S.C. §103(a) as being obvious over Hawker in view of Nesburn et al. (U.S. Pat. No. 5,431,790, hereinafter "Nesburn").

These rejections are respectfully traversed for the reasons noted below.

Amendments to the Claims

No amendments have been submitted for entry with this response. Accordingly, claims 1-64 as originally filed remain in the application and are under consideration.

Rejection under 35 U.S.C. §102

Claims 1-7 and 11-64 stand rejected under 35 U.S.C. §35 U.S.C. §102(b) as being anticipated by Hawker et al. (US Patent No. 6,107,357, hereinafter "Hawker").

In the Office Action, a number of specific citations to Hawker have been relied upon to suggest support for the anticipation rejection. Applicants respectfully submit, however, that there are clear patentable differences between the present claimed invention and Hawker. Some of these differences are as follows:

For example, Hawker is noted in the Office Action as disclosing synthetic polymer molecules "having a plurality of crosslinkable groups" that are "inert until activated" but which undergo an "irreversible intramolecular crosslinking reaction" when activated. A "method for preparing crosslinked particles" according to claim 1 in which the "crosslinkable groups of the synthetic polymer molecules are activated" such that "irreversible intramolecular crosslinking of the polymer molecules occurs to form crosslinked particles" is also said to be described by Hawker. Applicants respectfully disagree that Hawker discloses such information, or that this reference anticipates their invention as claimed.

More specifically, in the Action at page 2, certain passages at column 3, lines 63-67; column 4, lines 1-9; column 5, lines 54-67; column 6, lines 1-37; and column 9, lines 7-19, have been cited as providing support for the argument that Hawker discloses "intramolecular crosslinking." This interpretation of Hawker, however, is incorrect. Instead, the information noted from Hawker relates to the crosslinking reaction that takes place between the host polymer, the porogen and the coupling agent, wherein the coupling agent may be represented by the formula R^1-L-R^2, R^1 being a functional group that

enables covalent binding to the reactive site of the porogen and R^2 a functional group that enables covalent binding to the reactive site of the host polymer. In this reaction, as described by Hawker, the mixture of the host polymer, the porogen and the coupling agent are heated to "couple the porogen to the host polymer via the coupling agent" (e.g., see column 4, lines 3-4 and column 10, lines 6-29). This reaction should not be confused with "intramolecular crosslinking," that is, crosslinking within one molecule, since clearly the crosslinking reaction described by Hawker involves the intermolecular reaction between the three components noted above, the host polymer, the porogen and the coupling agent.

Applicants further note that nothing in Hawker's description explicitly mentions, or appears to implicitly relate to, "intramolecular crosslinking" as claimed by applicants. In fact, the terminology "intramolecular crosslinking" is not even mentioned in Hawker at all. As such, Hawker is not properly read to anticipate applicants' claims at least for the reason that each of the features claimed by applicants' is not disclosed.

Although not stated in the Office Action, to the extent that the Examiner may possibly consider that the "intramolecular crosslinking" is somehow an inherent feature of the Hawker's crosslinking reaction, applicants respectfully note that there is no basis for this assumption. Instead, as noted above, the crosslinking reaction referred to by Hawker involves the intermolecular reaction between more that one component, not an intramolecular reaction.

As pointed out in MPEP §2131, a reference must teach every element of a claim to constitute an anticipation, i.e., "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

In the present case, Hawker fails to explicitly or inherently describe intramolecular crosslinking according to applicants' invention and claims. As such, the presently claimed invention is not anticipated.

For at least the foregoing reasons, applicants respectfully submit that the present claims are not anticipated. Withdrawal of the 35 U.S.C. §102 rejection based on Hawker is requested.

Rejection under 35 U.S.C. §103(a)

Claims 8-10 stand rejected under 35 U.S.C. §35 U.S.C. §103(a) as being obvious over Hawker et al. (US Patent No. 6,107,357, hereinafter "Hawker") in view of Nesburn et al. (U.S. Pat. No. 5,431,790, hereinafter "Nesburn").

In the Office Action, the argument for rejecting the claims based on Hawker as cited in paragraph 2 of the Action, has been incorporated in the above obviousness rejection. Notwithstanding the additional ground for rejection cited under §103(a) noted in the Action, applicants submit, for reasons noted above, that Hawker fails to disclose or suggest "intramolecular crosslinking." As such, the present claims, including claims 8-10, are patentable over Hawker and the combination of Hawker and Nesburn.

In addition, applicants note that Nesburn does not correct the deficiencies of Hawker concerning "intramolecular crosslinking" such that claims 8-10 are patentable over the combination of applied documents for this reason as well.

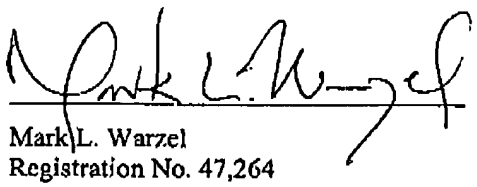
For at least the foregoing reasons, applicants respectfully submit that the present claims are not obvious over the combination of Hawker and Nesburn. Withdrawal of the 35 U.S.C. §103 rejection based on these references is requested.

Conclusion

Accordingly, applicants respectfully submit that the pending claims are novel and nonobvious over the art, and are in condition for allowance. A prompt notification to that effect would be appreciated.

If the Examiner has any questions concerning this amendment or the accompanying remarks, a telephone call to the undersigned would be appreciated.

Respectfully submitted,

By: 

Mark L. Warzel
Registration No. 47,264

Reed Intellectual Property Law Group
800 Menlo Avenue, Suite 210
Menlo Park, California 94025
(650) 330-0900 Telephone
(650) 330-0980 Facsimile